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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/704,434 *	11/02/2000	Yuichi Yamagami	2271/62705	4780

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EXAMINER

COSIMANO, EDWARD R

ART UNIT	PAPER NUMBER
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3629

DATE MAILED: 05/19/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/704,434

Applicant(s)

YAMAGAMI ET AL.

Examiner

Edward R. Cosimano

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 02 November 2000.
2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-16 is/are pending in the application.
4a) Of the above claim(s) none is/are withdrawn from consideration.
5) ☐ Claim(s) _____ is/are allowed.
6) ☒ Claim(s) 1-16 is/are rejected.
7) ☐ Claim(s) _____ is/are objected to.
8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
10) ☒ The drawing(s) filed on 02 November 2000 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 20001102.
4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

1. Applicant should note the changes to patent practice and procedure:
 - A) effective December 01, 1997 as published in the Federal Register, Vol 62, No. 197, Friday October 10, 1997;
 - B) effective November 07, 2000 as published in the Federal Register, Vol 65, No. 54603, September 08, 2000; and
 - C) Amendment in revised format, Vol. 1267 of the Official Gazette published February 25, 2003.
2. The drawings are objected to because
 - A) the following errors have been noted in the drawings:
 - (1) The drawings are objected to as failing to comply with 37 CFR § 1.84(p)(5) because they include the following reference sign(s) not mentioned in the description:
 - (a) 226 of fig. 2 as this figure is described in the paragraph at page 7, lines 1-16, "The following steps take place ... 220 or in some other way, electronic or hard copies."
 - (b) 408 of fig. 4 as this figure is described in the paragraph between page 7, line 25, and page 8, line 14, "Referring to Fig. 4, the process ... different carrier, for slower but less expensive shipping, etc."
 - (c) 510 of fig. 5 as this figure is described in the paragraph at page 8, lines 15-24, "Referring to Fig. 5, a flowchart ... in the one country, the U.S. in this example."
- 2.1 A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.
- 2.2 Applicant is required to submit a proposed drawing correction in reply to this Office action. However, formal correction of the noted defect may be deferred until after the examiner has considered the proposed drawing correction. Failure to timely submit the proposed drawing correction will result in the abandonment of the application.

3. The disclosure is objected to because of the following informalities:

A) as required by 37 CFR § 1.84(p(5)) and 37 CFR § 1.121(e) the specification lacks an explicit reference to the nature of:

(1) reference legend(s):

(a) 226 of fig. 2 as this figure is described in the paragraph at page 7, lines 1-16, "The following steps take place ... 220 or in some other way, electronic or hard copies.";

(b) 408 of fig. 4 as this figure is described in the paragraph between page 7, line 25, and page 8, line 14, "Referring to Fig. 4, the process ... different carrier, for slower but less expensive shipping, etc."; and

(c) 510 of fig. 5 as this figure is described in the paragraph at page 8, lines 15-24, "Referring to Fig. 5, a flowchart ... in the one country, the U.S. in this example."

In this regard, it is noted that merely mentioning either a feature or a number with out mentioning the device or operation or number or feature relies on the drawing to provide support for the disclosure and not to aid in the understanding of the invention, as is the purpose of the drawings (37 CFR § 1.81(a,b)).

B) the following errors have been noted in the specification:

(1) as can be seen in fig. 2 and from the context of the disclosure in the paragraph at page 6, lines 16-28, "If the test at step 200 determines that the ordered item is not in inventory Charge to the shipper from a shipper such as UPS.", at line 1 of this paragraph "200" should be --202--.

(2) the specification lacks a statement of --We claim:--, (see MPEP 608.01(m)).

Appropriate correction is required.

4. The specification and drawings have not been checked to the extent necessary to determine the presence of all possible minor errors. Applicant's cooperation is requested in correcting any errors of which applicant may become aware in the specification or drawings.

Applicant should note the requirements of 37 CFR § 1.74, § 1.75, § 1.84(o,p(5)), § 1.121(a)-1.121(f) & § 1.121(h)-1.121(i).

5. Claims 1-16 are rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

5.1 In regard to claim 1, since it is vague, indefinite and unclear from this claim exactly how the computed difference would be used to manage shipping charges, one of ordinary skill could not determine whether or not a system/method of allocating among a plurality of customers the cost of shipping an aggregated/consolidated shipment of the customer's individual orders is covered by the instant claim.

5.2 In regard to claim 6, since it is vague, indefinite and unclear from this claim exactly how the computed difference of two unrelated shipping charges would be used, one of ordinary skill could not determine whether or not a system/method that determines the difference between two separate methods of determining the cost of shipping items via two different shipping entities for an aggregated/consolidated shipment of the customer's individual orders from one country to another country is covered by the instant claim.

5.3 In regard to claim 14, since it is vague, indefinite and unclear from this claim exactly how the computed difference in shipping charges would be used, one of ordinary skill could not determine whether or not a system/method that determines the difference between two separate shipping charges for shipping items via two different shipping entities for an aggregated/consolidated shipment of the customer's individual orders from one country to another country is covered by the instant claim.

5.4 Claims 1-13, 15 & 16 are inoperative and therefore lack utility for the recited purpose of the disclosed and claimed invention, since:

A) each of claims 1 & 6 recite "managing shipping charges", however, none of these claims recite a step or machine/system that one of ordinary skill would recognize as performing the function of managing. Hence, these claims do not accomplish the intended purpose of managing shipping charges as recite in these claims.

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For as the Court has specifically pointed out, claims must recite utility for the disclosed purpose of the invention, (General Electric Co. V. U.S., 198 U.S.P.Q. 65 (U.S. Court of Claims, 1978), Hanson v. Alpine Valley Ski Area 204 U.S.P.Q. 794 (District Court, E. D. Michigan, N. Div. 1978) and Banning v. Southwestern Bell Telephone C., 182 U.S.P.Q. 683 (SD Tex, 1974)).

5.5 Applicant's inclusion of the system claims 15 & 16 into method/process claim 6/13 by dependency creates an improper hybrid claim and hence this combination of claimed subject matter is confusing. This confusion occurs, since it can not be determined into which one of the statutory classes of invention the combined claim is to be classified as, that is either:

- A) a process, or
- B) a machine, or
- C) a manufacture, or
- D) a composition of matter.

Note ex parte Lyell, 17 USPQ 2nd 1548 (Bd. Pat. App. & Inter. 1990) and MPEP § 2173.05(p).

5.6 Claims not specifically mentioned above, inherit the defects of the base claim through dependency. For the above reason(s), applicant has failed to particularly point out what is regarded as the invention.

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. § 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the

effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

6.1 Claim 1 is rejected under 35 U.S.C. § 102(b) as being clearly anticipated by the American Gas article.

6.1.1 In regard to claim 1, the American Gas article discloses that shipping companies look at the computed difference between the estimated shipping cost, i.e. second shipping charges, and actual shipping costs, i.e. first shipping charges, in order to manage shipping charges by passing the computed difference on to shippers in next year's rating structure.

6.2 Claim 1 is rejected under 35 U.S.C. § 102(e) as being clearly anticipated by Arunapuram et al (2002/0019759).

6.2.1 In regard to claim 1, the Arunapuram et al ('759) discloses that shipping companies look at the computed difference between the estimated shipping cost, i.e. second shipping charges, based on various shipping parameters, for example size, weight, special handling, etc., and actual shipping costs, i.e. first shipping charges, based on various shipping parameters, in order to manage shipping charges by optimizing shipping cost passing on to the customers and thereby increase customer satisfaction. Further, Arunapuram et al ('759) disclose that shipping costs of moving a consolidated freight shipment from one or more origin points to the customer are appropriately allotted to customers.

7. The following is a quotation of 35 U.S.C. § 103 which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

(c) Subject matter developed by another person, which qualifies as prior art only under subsection (f) or (g) of section 102 of this title, shall not preclude patentability

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under this section where the subject matter and the claimed invention were, at the time the invention was made, owned by the same person or subject to an obligation of assignment to the same person.

7.1 Claims 2-16 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Arunapuram et al (2002/0019759) as applied to claim 1 and further in view of well established practice, note applicant's admissions in the paragraph between page 1, line 21, and page 2, line 7, "The assignee hereof has fully stocked as the overseas warehouse.", and Gerety.

7.1.1 In regard to the international shipping of claims 2, 3, 6-9 & 14, it is respectfully noted that many foreign built cars, electronic devices, etc, are shipped to different customers in the United States, via ship, plane, etc. from the foreign country that the item was manufactured in to a port of call in the U.S. as a consolidated shipment. After the consolidated shipment reaches the port of call, the items contained in the consolidated shipment are off loaded and then redistributed to the item's final destination by loaded the item(s) onto one or more second forms of transportation, for example, train, truck, etc. which are used to transport the item to it's final destination, where either of these transportations may include one or more legs with intermediate destinations. In this regard, the total transportation cost would be the sum of the transportation costs for each individual carrier and associated fees

7.1.2 In regard to the use of the item's weight in claims 4, 11 & 16, one of the shipping parameters of Arunapuram et al ('759) is weight.

7.1.3 In regard to the use of zones in claims 5, 10, 12 & 16, note Gerety which in 1986 discloses the use of a zone based structure for rating freight costs between various origins and destinations.

7.1.4 In regard to claims 13 & 15, it is noted that the purpose of Arunapuram et al ('759) is to find the optimal transportation plan which inherently would include repeated calculations of transportations costs on a routine basis.

8. The examiner has cited prior art of interest, for example:

A) Schuricht et al (5,070,463) which discloses that shipping charges for each item in an aggregate/consolidated shipment are determined from the weight, origin,

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destination, special service and the carrier to be used for each item in the consolidated shipment.

B) Machida et al (JP 04-115358) which discloses that an electronic file containing the specifications of goods to be shipped is used to estimate the shipping fee.

C) Paul (6,356,838) which discloses various rating structures that a flat fee per mile or a flat fee per trip for transporting shipments.

D) Altendahl et al (6,571,213) which disclose prorating the cost of a shipment of a consolidated shipment of parcels among each of the parcels in the consolidated shipment.

9. The shorten statutory period of response is set to expire 3 (three) months from the mailing date of this Office action.

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Edward Cosimano whose telephone number is (703) 305-9783. The examiner can normally be reached Monday through Thursday from 7:30am to 6:00pm. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Weiss, can be reached on (703)-308-2702. Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 308-1113.

10.1 The fax phone number for UNOFFICIAL/DRAFT FAXES is (703) 746-7240.

10.2 The fax phone number for OFFICIAL FAXES is (703) 872-9306.

10.3 The fax phone number for AFTER FINAL FAXES is (703) 872-9306.

05/12/04



Edward R. Cosimano

Primary Examiner A.U. 3629